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**REMARKS**

This response is intended as a full and complete response to the non-final Office Action mailed December 16, 2004. In the Office Action, the Examiner rejected claims 1-69 and objected to claims 30, 31 and 34.

Claims 1-20 and 22-69 are pending. Claim 21 is cancelled without prejudice or disclaimer. Claim 19 is amended to include the subject matter of cancelled claim 21. Claims 1, 8, 13, 14, 16-19, 22, 30, 31, 34-39, 41, 42, 44, 50, 51, 54-57, 59, 60, 61, 64, and 67 are amended to correct formal matters, such as spelling and antecedent basis. The amendments contain no new matter and are supported by Applicants' original specification, including the claims and drawings.

In view of both the amendments presented above and the following remarks, Applicants respectfully submit that the claims are patentable over the cited references under 35 U.S.C. §§102 and 103. Thus, Applicants believe that all the claims are allowable.

It is to be understood that Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or of Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

**OBJECTIONS TRAVERSED**

The Examiner has objected to claims 30, 31 and 32 stating that, the limitations "said sites" in claim 30, line 5, said database in claim 31, line 1, and "the iTV Service Provider point of presence" in claim 34, lines 2-3, lack antecedent basis. Applicants respectfully traverse the objections, because claims 30, 31, and 34 are amended to add antecedent basis.

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**CLAIMS PATENTABLE UNDER 35 U.S.C. §102****A. Claims 19, 22-25, 28, 32-37, 42, 45-47, 50, 52, 54, 56, 57, 59, 64, and 67-69**

The Examiner rejected claims 19, 22-25, 28, 32-37, 42, 45-47, 50, 52, 54, 56, 57, 59, 64 and 67-69 under 35 U.S.C. §102(a/e) as being anticipated by U.S. Patent No. 6,088,722 to Herz et al. ("Herz").

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). The Herz reference fails to disclose each and every element of the claimed invention, as arranged in the claim.

Applicants respectfully traverse the rejection, because Herz fails to disclose each and every element of the claimed invention.

Claim 22 recites "A method of profiling iTV users, comprising: providing profiles on a plurality of iTV programs; monitoring which of said plurality of iTV programs a user accesses; and developing a profile of the user based on the profiles of the iTV programs accessed by the user." Herz fails to disclose each element of claim 22, because Herz fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user. By contrast, Herz teaches creating a customer profile indicating the customer's preferences for predetermined characteristics of video programming before updating the customer profile based on video programs actually watched. (Herz, col. 6, lines 43-63). Thus, the customer profiles in Herz start with the customer's preferences for predetermined characteristics, while the claimed invention develops the profile of the user based only on the profiles of the iTV programs accessed by the user. Therefore, claim 22 is patentable over Herz under 35 U.S.C. §102(a/e).

Claim 19 recites, *inter alia*, "developing a user profile based on the content-associated profile information correlated with the user-requested content information". For the same reasons given above with respect to claim 22, claim 19 is also patentable over Herz under 35 U.S.C. §102(a/e).

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Claim 50 recites "A set-top box including a memory for storing a program and a processor operative with the program to perform a method of profiling iTV users, the method comprising: monitoring which of a plurality of programs a user views; and developing a profile of the user based on predetermined profiles of the programs viewed by the user." For the same reasons given above with respect to claim 22, claim 50 is also patentable over Herz under 35 U.S.C. §102(a/e).

Claim 57 recites "A computer having a memory for storing a program and a processor operative with the program to perform a method of profiling iTV users, the method comprising: monitoring which of a plurality of programs a user views; and developing a profile of the user based on predetermined profiles of the viewed television programs." For the same reasons given above with respect to claim 22, claim 57 is also patentable over Herz under 35 U.S.C. §102(a/e).

Claim 59 recites "A system for delivering selective advertising to iTV users, comprising: a database containing profile data on a plurality of iTV programs; means for monitoring which iTV programs a user accesses; means for developing a profile of the user using profile data of the accessed iTV programs; and means for matching the user with an advertisement based on the developed user profile." For the same reasons given above with respect to claim 22, claim 59 is also patentable over Herz under 35 U.S.C. §102(a/e).

Claim 64 recites "A computer readable medium storing instructions thereon to perform a method of profiling iTV users, the method comprising: monitoring which of a plurality of fly programs having predetermined profiles a user accesses; and developing a profile of the user based on the profiles of the accessed iTV programs." For the same reasons given above with respect to claim 22, claim 64 is also patentable over Herz under 35 U.S.C. §102(a/e).

Claim 67 recites, *inter alia*, "monitoring which of said iTV programs each user visits" and "inferring a profile of each user based on the profiles of the visited iTV programs". For the same reasons given above with respect to claim 22, claim 67 is also patentable over Herz under 35 U.S.C. §102(a/e).

Claim 69 recites, *inter alia*, "a profiler for correlating content-associated profile information from a rating service with the user-requested content information and for

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developing a profile of the user". For the same reasons given above with respect to claim 22, claim 69 is also patentable over Herz under 35 U.S.C. §102(a/e).

In light of the remarks above, Applicants respectfully submit that independent claims 19, 22, 50, 57, 59, 64, 67 and 69 are not anticipated by Herz. It is believed that claims 19, 22, 50, 57, 59, 64, 67 and 69 are allowable under 35 U.S.C. §102(a/e). Furthermore, dependent claims 23-25, 28, 32-37, 42, 45-47, 52, 54, 56 and 68 depend directly or indirectly from one of independent claims 19, 22, 50, 57, 59, 64, 67 and 69 and recite additional elements. As such and for at least the same reasons discussed above with respect to claim 22, Applicants submit that these dependent claims are also not anticipated by Herz and are allowable under 35 U.S.C. §102. Therefore, Applicants respectfully request that the rejections be withdrawn.

#### **REJECTION UNDER 35 U.S.C. §103**

##### **A. Claims 1-4, 9-11, 17, 18, 30, 31 and 51**

Claims 1-4, 9-11, 17, 18, 30, 31 and 51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent No. 5,659,350 to Hendricks et al. ("Hendricks"). Applicants respectfully traverse the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Herz and Hendricks references alone or in combination fail to teach, show or suggest Applicants' invention as a whole.

To establish *prima facie* obviousness of a claimed invention, all the claim elements must be taught or suggested by the proposed combination. The combination of Herz and Hendricks fails to teach or suggest all the claim elements, because, for example, Herz fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user.

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Claim 1 recites "A method for profiling iTV user, comprising: gathering user-requested content information from iTV interactions; correlating content-associated profile information from a rating service with the user-requested content information; and developing a profile of a user based on the content-associated profile information correlated with the user-requested content information." Herz fails to disclose each element of claim 1, because Herz fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user. By contrast, Herz teaches creating a customer profile indicating the customer's preferences for predetermined characteristics of video programming before updating the customer profile based on video programs actually watched. (Herz, col. 6, lines 43-63). Thus, the customer profiles in Herz start with the customer's preferences for predetermined characteristics, while the claimed invention develops the profile of the user based only on the profiles of the iTV programs accessed by the user. Furthermore, Hendricks fails to bridge the substantial gap between the Herz reference and Applicants' invention. In particular, Hendricks fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user. Therefore, claim 1 is patentable over the combination of Herz and Hendricks under 35 U.S.C. §103(a).

Claim 17 recites, *inter alia*, "developing a profile of a user based on the content-associated profile information correlated with the user-requested content information". For the same reasons given above with respect to claim 1, claim 17 is also patentable over the combination of Herz and Hendricks under 35 U.S.C. §103(a).

Claim 18 recites, *inter alia*, "developing a profile of a user based on the content-associated profile information correlated with the user-requested content information". For the same reasons given above with respect to claim 1, claim 18 is also patentable over the combination of Herz and Hendricks under 35 U.S.C. §103(a).

In light of the remarks above, Applicants submit that independent claims 1, 17 and 18 are not obvious in view of Herz and Hendricks alone or in combination. It is believed that claims 1, 17 and 18 are allowable under 35 U.S.C. §103(a). Furthermore, dependent claims 2-4, 9-11, 30, 31 and 51 depend indirectly from one of independent claims 1, 17 and 18 and recite additional elements. As such and for at least the same reasons discussed above with respect to claims 1, 17 and 18, Applicants submit that

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these dependent claims are also not obvious in view of Herz and Hendricks alone or in combination and are allowable under 35 U.S.C. §103. Therefore, Applicants respectfully request that the rejection be withdrawn.

#### **B. Claims 5-8**

Claims 5-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Herz and Hendricks in view of U.S. Patent No. 5,223,924 to Strubbe ("Strubbe"). This rejection is respectfully traversed.

Claims 5-8 are dependent directly or indirectly upon independent claim 1. For the reasons discussed above, Applicants' independent claim 1 is patentable and non-obvious over the Herz and Hendricks references alone or in combination. For at least the same reasons, dependent claims 5-8 are patentable and non-obvious over the Herz and Hendricks references alone or in combination.

Strubbe fails to bridge the substantial gap between the Herz and Hendricks references and Applicants' invention, because Strubbe fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user.

Therefore, Herz, Hendricks and Strubbe alone or in combination fail to teach, show or suggest Applicants' invention as a whole.

In light of the remarks above, Applicants respectfully submit that independent claim 1 is not obvious in view of Herz, Hendricks and Strubbe alone or in combination. It is believed that claim 1 is allowable under 35 U.S.C. §103(a). Furthermore, dependent claims 5-8 depend directly or indirectly from independent claim 1 and recite additional elements. As such and for at least the same reasons discussed above with respect to claim 1, Applicants submit that these dependent claims are also not obvious in view of Herz, Hendricks and Strubbe alone or in combination and are allowable under 35 U.S.C. §103(a). Therefore, Applicants respectfully request that the rejections be withdrawn.

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**C. Claims 12-16**

Claims 12-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent 5,848,396 to Gerace (Gerace). This rejection is respectfully traversed.

Claims 12-16 are dependent directly or indirectly upon independent claim 1. For the reasons discussed above, Applicants' independent claim 1 is patentable and non-obvious over the Herz reference. For at least the same reasons, dependent claims 12-16 are patentable and non-obvious over the Herz reference.

Gerace fails to bridge the substantial gap between the Herz reference and Applicants' invention. Nowhere in the Gerace reference is there any teaching or suggestion of developing a profile of a user based only on the profiles of the iTV programs accessed by the user. Therefore, the Herz and Gerace references alone or in combination fail to teach, show or suggest Applicants' invention as a whole.

In light of the remarks above, Applicants respectfully submit that independent claim 1 is not obvious in view of Herz and Gerace alone or in combination. It is believed that claim 1 is allowable under 35 U.S.C. §103(a). Furthermore, dependent claims 12-16 depend directly or indirectly from independent claim 1 and recite additional elements. As such and for at least the same reasons discussed above with respect to claim 1, Applicants respectfully submit that these dependent claims are also not obvious in view of Herz and Gerace alone or in combination and are allowable under 35 U.S.C. §103. Therefore, Applicants respectfully request that the rejections be withdrawn.

**D. Claim 20**

Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Herz in view of Strubbe. This rejection is respectfully traversed.

Claim 20 is dependent directly upon independent claim 19. For the reasons discussed above, Applicants' independent claim 19 is patentable and non-obvious over the Herz reference. For at least the same reasons, dependent claim 20 is patentable and non-obvious over the Herz reference.

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Strubbe fails to bridge the substantial gap between the Herz reference and Applicants' invention. Nowhere in the Strubbe reference is there any teaching or suggestion of developing a profile of a user based only on the profiles of the iTV programs accessed by the user. Therefore, the Herz and Strubbe references alone or in combination fail to teach, show or suggest Applicants' invention as a whole.

In light of the remarks above, Applicants respectfully submit that independent claim 19 is not obvious in view of the Herz and Strubbe references alone or in combination. It is believed that claim 19 is allowable under 35 U.S.C. §103(a). Furthermore, dependent claim 20 depends directly from independent claim 19 and recites additional elements. As such and for at least the same reasons discussed above with respect to claim 19, Applicants respectfully submit that this dependent claim is also not obvious in view of the Herz and Strubbe references alone or in combination and are allowable under 35 U.S.C. §103(a). Therefore, Applicants respectfully request that the rejections be withdrawn.

#### **E. Claim 21**

Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Herz and Strubbe in view of Hendricks. This rejection is respectfully traversed.

Claim 21 is dependent indirectly upon independent claim 19. For the reasons discussed above, Applicants' independent claim 19 is patentable and non-obvious over the Herz reference. For at least the same reasons, dependent claim 21 is patentable and non-obvious over the Herz reference.

Strubbe and Hendricks alone or in combination fail to bridge the substantial gap between the Herz reference and Applicants' invention. Nowhere in the Strubbe or Hendricks references is there any teaching or suggestion of developing a profile of a user based only on the profiles of the iTV programs accessed by the user. Therefore, the Herz, Strubbe and Hendricks references alone or in combination fail to teach, show or suggest Applicants' invention as a whole.

In light of the remarks above, Applicants respectfully submit that independent claim 19 is not obvious in view of the Herz, Strubbe and Hendricks references alone or in combination. It is believed that claim 19 is allowable under 35 U.S.C. §103(a).

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Furthermore, dependent claim 21 depends directly from independent claim 19 and recites additional elements. As such and for at least the same reasons discussed above with respect to claim 19, Applicants respectfully submit that this dependent claim is also not obvious in view of the Herz, Strubbe and Hendricks references alone or in combination and are allowable under 35 U.S.C. §103(a). Therefore, Applicants respectfully request that the rejections be withdrawn.

**F. Claims 26, 27, 29, 41, 43, 44, 49, 53, 55, 58, 60-62, 65 and 66**

**1. Claims 26, 27, 29, 41, 43, 44, 49, 53, 55 and 58**

Claims 26, 27, 29, 41, 43, 44, 49, 53, 55 and 58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Herz. Applicants respectfully traverse the rejection.

Claims 26, 27, 29, 41, 43, 44, and 49 are dependent directly or indirectly upon independent claim 22. Claims 53 and 55 are dependent directly on independent claim 50 and claim 58 is dependent directly upon independent claim 57. For the reasons discussed above, Applicants' independent claims 22, 50 and 57 are patentable and non-obvious over the Herz reference. For at least the same reasons, dependent claims 26, 27, 29, 41, 43, 44, 49, 53, 55 and 58 are patentable and non-obvious over the Herz reference.

As discussed above, the Herz reference fails to teach or suggest Applicants' invention as a whole, because Herz fails to disclose developing a profile of a user based only on the profiles of the iTV programs accessed by the user.

In light of the remarks above, Applicants respectfully submit that independent claims 22, 50 and 57 are not obvious in view of Herz. It is believed that claims 22, 50 and 57 are allowable under 35 U.S.C. §103(a). Furthermore, dependent claims 26, 27, 29, 41, 43, 44, and 49 are dependent directly or indirectly upon independent claim 22; claims 53 and 55 are dependent directly on independent claim 50; and claim 58 is dependent directly upon independent claim 57. As such and for at least the same reasons discussed above with respect to claims 22, 50 and 57, Applicants respectfully submit that these dependent claims are also not obvious in view of Herz and are allowable under 35 U.S.C. §103(a). Therefore, Applicants respectfully request that the rejection be withdrawn.

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**2. Claims 60-62, 65 and 66**

Claims 60-62, 65 and 66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Herz. Applicants respectfully traverse the rejection. Applicants' independent claim 60 recites, *inter alia*, "monitoring which of a plurality of iTV programs the user accesses and means for developing a profile of the user based on predetermined profile data of iTV programs accessed by the user". As discussed above, the Herz reference fails to teach, show or suggest Applicants' invention as a whole, because Herz fails to disclose developing a profile of a user based only on the profiles of the iTV programs accessed by the user.

In light of the remarks above, Applicants respectfully submit that independent claim 60 is not obvious in view of Herz. It is believed that claim 60 is allowable under 35 U.S.C. §103(a). Furthermore, dependent claims 61, 62, 65 and 66 depend directly or indirectly from independent claim 60 and recite additional elements. As such and for at least the same reasons discussed above with respect to claim 60, Applicants respectfully submit that these dependent claims are also not obvious in view of Herz and Hendricks alone or in combination and are allowable under 35 U.S.C. §103(a). Therefore, Applicants respectfully request that the rejection be withdrawn.

**G. Claims 38-40 and 48**

Claims 38-40 and 48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent 6,005,597 to Barrett et al. (Barrett). Applicants respectfully traverse the rejection.

Claims 38-40 and 48 are dependent directly or indirectly upon independent claim 22. For the reasons discussed above, Applicants' independent claim 22 is patentable and non-obvious over the Herz reference. For at least the same reasons, dependent claims 38-40 and 48 are patentable and non-obvious over the Herz reference.

As discussed above, the Herz reference fails to disclose developing a profile of a user based only on the profiles of the iTV programs accessed by the user.

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Furthermore, the Barrett reference fails to bridge the substantial gap between the Herz reference and Applicants' invention, because Barrett also fails to disclose developing a profile of a user based only on the profiles of the iTV programs accessed by the user. Therefore, the Herz and Barrett references alone or in combination fail to teach, show or suggest Applicants' invention as a whole.

In light of the remarks above, Applicants submit that independent claim 20 is not obvious in view of Herz and Barrett alone or in combination. It is believed that claim 22 is allowable under 35 U.S.C. §103. Furthermore, dependent claims 38-40 and 48 are dependent directly or indirectly upon independent claim 22. As such and for at least the same reasons discussed above with respect to claims 22, 50 and 57, Applicants submit that these dependent claims are also not obvious in view of Herz and Barrett alone or in combination and are allowable under 35 U.S.C. §103. Therefore, Applicants respectfully request that the rejection be withdrawn.

#### **G. Claim 63**

Claim 63 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent 6,708,335 to Ozer et al. (Ozer). Applicants respectfully traverse the rejection.

Claim 63 is dependent directly upon independent claim 60. For the reasons discussed above, Applicants' independent claim 60 is patentable and non-obvious over the Herz reference. For at least the same reasons, dependent claim 63 is patentable and non-obvious over the Herz reference.

As discussed above, the Herz reference fails to disclose developing a profile of a user based only on the profiles of the iTV programs accessed by the user. Furthermore, the Ozer reference fails to bridge the substantial gap between the Herz reference and Applicants' invention, because nowhere in the Ozer reference is there any teaching or suggestion of developing a profile of a user based only on the profiles of the iTV programs accessed by the user. Therefore, the Herz and Ozer references alone or in combination fail to teach, show or suggest Applicants' invention as a whole.

In light of the remarks above, Applicants respectfully submit that independent claim 60 is not obvious in view of Herz and Ozer alone or in combination. It is believed

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that claim 22 is allowable under 35 U.S.C. §103(a). Furthermore, dependent claims 38-40 and 48 are dependent directly or indirectly upon independent claim 22. As such and for at least the same reasons discussed above with respect to claims 22, 50 and 57, Applicants respectfully submit that these dependent claims are also not obvious in view of Herz and Ozer alone or in combination and are allowable under 35 U.S.C. §103(a). Therefore, Applicants respectfully request that the rejection be withdrawn.

### Secondary References

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the Office Action. Therefore, the Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

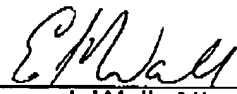
### CONCLUSION

Applicants submit that claims 2-22 are in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 5/16/05

  
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